

In re BORGEN  
09/916,256

REMARKS

The Examiner is thanked for the Final Action dated May 07, 2003. The above amendment and remarks to follow are intended to be fully responsive to the issues presented in that Action.

The disclosure was objected to for several minor informalities which have been corrected by the above amendment. No new matter has been entered.

Claim 18 was objected to for including the term “whereby”. Notwithstanding the decision in *In re Mason*, 114 USPQ 127 (CCPA (1957)), the Federal Circuit has clearly stated that it is improper to disregard the preamble and all limitations that include “adapted to,” “whereby,” and “thereby” in determining whether a claim is anticipated by the prior art – particularly where the “whereby” clause adds structure to the claim. *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 276, 14 USPQ2d 1871 (Fed. Cir. 1990), *cert. denied*, 502 U.S. 808 (1991).

Claims 1-8, 10-18 and 22 were rejected under 35 U.S.C. §112, second paragraph, for indefinite claim language. Applicant has reviewed and amended the claims for adherence to the requirements of §112. No new matter has been entered.

Claims 1, 2, 4, 13 and 18 were rejected under 35 U.S.C. §102(b) as being anticipated by Balmforth (USP 4,914,979). Claims 1-8 and 10-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Balmforth (USP 4,914,979) in view of Hunt (USP 5,996,720). This rejection is respectfully traversed in view of the above amendment and the following comments.

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*Not Claimed*  
No prior art teaches an axle disconnect assembly (for a tandem vehicle) whereby an axle is disconnected from its associated differential. The examiner incorrectly asserts that Balmforth '979 teaches a "second clutch means as shown in figure 7 which engages and disengages the axle shafts 111, 112 of a third drive axle from a differential assembly". There is no mechanism in Balmforth '979 whereby the axle shafts 111, 112 can be disconnected from the differential 110.

Regarding the structure of the present invention, the prior art fails to teach or render obvious any arrangement (whereby the axle shafts (e.g., axle shaft 24, 25) are axially slidable with respect to their associated differential assembly.) Hunt '720 teaches a slidable clutch collar 34 and gears 30 – but Hunt '720 does not teach slidable axle shafts. *new issue*

In an effort to expedite prosecution, Applicant has amended independent claim 1 to include the limitations of dependent claim 22. No new issues are raised by this amendment.

It is respectfully submitted that this application is in condition for allowance and notice to that effect is earnestly solicited. Should the Examiners believe additional discussion would advance the prosecution of the instant application, please contact the undersigned.

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